

10/758455 (THUMB-604DIV) Related Proceedings Appendix (Supplement) – p. RPA-23

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES*Ex parte* CHARLES O. TOWNLEYAppeal 2010-000490
Application 09/352,472
Technology Center 3700RECEIVED JAN 08 2011 *CRK*Before TONI R. SCHEINER, DONALD E. ADAMS, and
LORA M. GREEN, *Administrative Patent Judges*.ADAMS, *Administrative Patent Judge*.DECISION ON APPEAL¹

Claims 31-36 and 38-55 are pending (App. Br. 1²). Of these claims, the Examiner has indicated that claims 42-53 and 55 are allowable (Ans. 2). This appeal under 35 U.S.C. § 134 involves claims 31-36, 38-41, and 54 are on appeal (*id.*; App. Br. 1). We have jurisdiction under 35 U.S.C. § 6(b).

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the "MAIL DATE" (paper delivery mode) or the "NOTIFICATION DATE" (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

² Received April 28, 2009.

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STATEMENT OF THE CASE

The claims are directed to a basal thumb joint implant. Claim 31 is representative and is reproduced in the "Claims Appendix" of Appellant's Brief under the header "If the 2/26 'AF' Amendment Is Entered" (App. Br. CA-7-9).³

The rejections presented by the Examiner follow:

1. Claims 31, 32, 40, and 54 stand rejected under 35 U.S.C § 103(a) as unpatentable over the combination of Wright⁴ and Tornier.⁵
2. Claims 31, 33, and 35 stand rejected under 35 U.S.C § 103(a) as unpatentable over the combination of Wright and Townley.⁶
3. Claims 31 and 35 stand rejected under 35 U.S.C § 103(a) as unpatentable over the combination of Wright and Steffee.⁷
4. Claims 31, 36, and 39 stand rejected under 35 U.S.C § 103(a) as unpatentable over the combination of Wright and Lippincott.⁸
5. Claim 34 stands rejected under 35 U.S.C § 103(a) as unpatentable over the combination of Wright, Tornier, and Townley.
6. Claim 38 stands rejected under 35 U.S.C § 103(a) as unpatentable over the combination of Wright, Steffee, and Tornier.

³ The Examiner entered Appellant's February 26, 2009 After Final Amendment (*see, e.g.*, Ans. 3).

⁴ Wright Technology Brochure of the Swanson implant submitted on September 1, 1999. The Examiner and Appellant refer to this reference as Swanson.

⁵ Tornier, US 5,405,399, issued April 11, 1995.

⁶ Townley, US 2,934,065, issued April 26, 1960.

⁷ Steffee, US 3,506,982, issued April 21, 1970.

⁸ Lippincott, III et al., US 5,405,401, issued April 11, 1995.

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7. Claim 41 stands rejected under 35 U.S.C § 103(a) as unpatentable over the combination of Wright, Lippincott, and Smith.⁹

We reverse.

ISSUE

Has the Examiner addressed Appellant's evidence submitted to rebut the Examiner's prima facie case of obviousness?

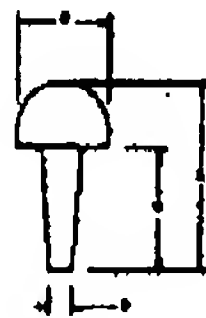
FINDINGS OF FACT

FF 1. The Examiner finds that Wright suggests:

[A] basal thumb joint having a head having an articulating surface defining a truncated ball of a shape that is "substantially hemispherical to greater than substantially hemispherical" with the articulating surface being continuous as to its sphericity. It can also be seen that the prosthesis includes a stem projecting from a planar end of the head.

(Ans. 4.)

FF 2. For clarity we reproduce the illustration of Wright's Swanson implant as it appears on page 2 of Wright and Wright's Figure 1b below:



TYPICAL DIMENSIONS (millimeters)

Size	1	2	3	4	5
A	19.3	20.9	22.8	24.5	26.3
B	13.0	14.0	15.0	16.1	17.3
C	9.5	10.4	11.5	12.6	13.6
D	2.5	2.8	3.0	3.2	3.4



⁹ Smith et al., US 3,314,420, issued April 18, 1967.

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The illustration provides typical dimensions of the Swanson implant.

Wright's Figure 1b provides a post-operative x-ray showing a titanium basal thumb implant in place in the hand (Wright 2: col. 1, illustration; 3: col. 2, Fig. 1b legend).

FF 3. The Examiner relies on Tornier, Townley, Steffee, Lippincott, and/or Smith to make up for Wright's failure to suggest various aspects of Appellant's claimed invention (Ans. 4-8).

ANALYSIS

Assuming *arguendo* that the Examiner established a prima facie case of obviousness on this record, the Examiner failed to address Appellant's rebuttal evidence (*see* Appellant's Evidence Appendix, EA-1 through EA-155¹⁰; *see also* Reply Br. 2 ("The Examiner improperly brushed aside" "the declaration evidence supporting the patentability of the appealed claims") and App. Br. 7-25). *Cf. In re Sullivan*, 498 F.3d 1345, 1353 (Fed. Cir. 2007) ("[B]y failing to consider the submitted evidence, the Board thus committed error"); *see also In re Hedges*, 783 F.2d 1038, 1039 (Fed. Cir. 1986). Since the Examiner failed to consider the record as a whole, including Appellant's rebuttal evidence, we are compelled to reverse the rejections before us on appeal.

¹⁰ Including, *inter alia*, the Declarations of Leslie, Pringle, Townley, and Rudy.

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CONCLUSION OF LAW

The Examiner failed to address Appellant's evidence submitted to rebut the Examiner's prima facie case of obviousness. All rejections of record are reversed.

REVERSED

clj

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